

In re Appln. KVITNITSKY
Appln. No. 10/553,757
Amendment dated December 1, 2009
Reply to OA mailed September 1, 2009

REMARKS

The Applicants filed a Supplemental Amendment and a Declaration Under 37 CFR §1.132 on August 31, 2009. The Office Action to which Applicants are presently replying was mailed September 1, 2009, and clearly the Examiner did not have the opportunity to consider either the Amendment of August 31, 2009, or the attached Rule 132 Declaration. Applicants now request that the Amendments presented above be entered following entry of the Supplemental Amendment filed August 31, 2009, and Applicants also request consideration of the remarks attached to the Amendment of August 31, 2009, and the Rule 132 Declaration of Dr. Belakhov attached thereto, executed by Dr. Belakhov on August 30, 2009.

The Official Action of September 1, 2009, has been carefully reviewed. The claims in the application are now claims 1-5 and 7-31), and these claims define patentable subject matter warranting their allowance. Favorable reconsideration and allowance are therefore earnestly solicited.

All the claims have been examined "to the extent that they read on the elected subject matter" and claims 1-5 and 7-9 have been "objected to for containing non-elected subject matter." The objection is respectfully traversed.

Applicants understand that the claims have so far been examined to the extent they read on the elected subject matter, but respectfully request the Examiner to point out the authority for objecting to claims for containing non-elected subject matter, and any requirement (not expressed) which might be implied by such an objection. Applicants believe that it is

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clear that an applicant may properly present generic claims, and that such generic claims will be allowed as presented unless rejected for some valid reason. Applicants know of no basis for objecting to claims because they are generic, i.e. because they contain non-elected subject matter.

Applicants appreciate that the claims rightfully have not been rejected as being generic, i.e. as containing non-elected subject matter, *In re Weber et al* 198 USPQ 328, 331 (CCPA 1978). Withdrawal of the objection is in order and is respectfully requested.

Claims 1-5 and 7-31 have been rejected under the first paragraph of §112 as not being enabled for making the specific salts (R^2 substituents) and regarding certain uses. This rejection is respectfully traversed in part for the reasons set forth in Applicants' Supplemental Reply filed August 31, 2009, and the attached Declaration Under 37 CFR §1.132 of Dr. Belakhov, as well as for the reasons previously set forth, respectfully repeated by reference.

As stated in the second paragraph in the Remarks of the Supplemental Reply filed August 31, 2009, Dr. Belakhov's Declaration addresses the rejections under the first paragraph of §112. The Declaration is self-explanatory, and Applicants again respectfully request the Examiner to read such Declaration in its entirety, and to give it full consideration. To avoid prolixity, Applicants will not repeat what is stated in such Declaration, except for briefly noting the conclusions reached.

Thus, at the top of page three and again on page 15, Dr. Belakhov declares that those skilled in the art would be

able to practice the invention as claimed based on what is disclosed in the present application, coupled with common knowledge in the field, i.e., 'compounds of the formula defined in claim 1 of the present application may be obtained, using various technologies and procedures that have all been described in the literature and are known to any person skilled in the art.' These conclusions are supported by the experiments which are described in the attached Declaration.

As stated by the Examiner with respect to the new lack-of-enablement rejection, '...the specification, while being enabling (based on prior art teaching) for some of the use of compositions containing ascorbic acids, does not reasonably provide enablement for the use of the compositions in treatment of all forms of cancer and immune system'. As further stated, 'Based on prior art teachings the use of ascorbic acid compounds in cosmetic, dermatological and nutraceutical application as well as in the treatment of cutaneous cancer and photo damaged skin can be acknowledged. However it is not seen wherein in the specification enabling disclosure is found for use of instant compositions in the treatment of all types of cancer and for the treatment of immune system in general'.

First in this regard, claims 16-18 have been deleted without prejudice to Applicants' rights to pursue these and/or similar claims in a continuing application, if Applicants choose to do so, and without any penalty whatsoever, Applicants in such a case relying on §§120 and 119.

The test results set forth in Dr. Belakhov's Declaration should establish without question that those skilled

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in the art would be enabled to use the claims compounds as proposed.

Withdrawal of the rejection is believed to be in order and is respectfully requested.

Applicants also wish to very briefly address the paragraph spanning pages 4 and 5 of the Office Action of September 1, 2009. Applicants continue to maintain that it is inconsistent, and even illogical, to take the position that it would have been obvious (§103) from certain prior art to practice an invention as set forth in a particular claim, and then at the same time to maintain that the same practice of the invention as set forth in that same claim would not have been enabled by the person skilled in the art having both the prior art to rely on and the applicant's added disclosure.

Notwithstanding the Declaration of Dr. Belakhov which should fully address both rejections, Applicants continue to maintain that it cannot be both obvious to practice the claimed invention and yet be incapable of practicing it.

Claims 1-5 and 7-14 have been rejected again as obvious under §103 from Shimizu and Streicher. This rejection is respectfully traversed for the reasons of records, respectfully repeated by reference, and for the additional reasons set forth in the Supplemental Reply of August 31, 2009, relying on Dr. Belakhov's Declaration.

In this latter regard, the claimed compounds possess a surprisingly improved stability making these compounds less sensitive to oxidative compounds such as free radicals, as noted

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on page three of Dr. Belakhov's Declaration, and his discussion on pages 6 and 17 thereof.

Withdrawal of the rejection is in order and is respectfully requested.

Applicants wish to briefly address the matter raised in the paragraph spanning pages 5 and 6 of the Office Action. Applicants had noted that Shimizu disclosed only one compound, and that all other compounds falling within the generic disclosure were only set forth in a huge 'basket' or 'shotgun' disclosure, whereby the possibility of coming up with the claimed subject matter would be approximately the same as figuring out the combination of a safe by looking at the dial.

As regards the salt form, in Shimizu it may be at any of the one, two or three positions, whereas it may be in only one position according to the present invention. Then, looking at the top of page three of Shimizu, the R¹ group may be any one of a wide variety of substituents including unsubstituted straight-chain or branched-chain alkyl groups, and substituted straight-chain or branched-chain alkyl groups, and the substituents may be any of the huge number set forth in the remainder of page three and on pages four and five. The number of possibilities should be compared with the options that one faces when looking at the dial of a safe.

Applicants therefore respectfully maintain their position that the claimed compounds are structurally non-obvious from the references, as well as being non-obvious on the basis of the surprisingly improved properties they possess, of which the prior art gives no reasonable expectation.

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The test results set forth in Dr. Belakhov's Declaration should establish without question that those skilled in the art would be enabled to use the claims compounds as proposed.

The prior art documents of record and not relied upon by the PTO have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of Applicants' claims.

Applicants believe that all issues raised in the Official Action have been addressed above in a manner that should lead to patentability of the present application. Favorable consideration and early formal allowance are respectfully requested.

If the Examiner has any questions or suggestions, he is respectfully requested to contact the undersigned at (202) 628-5197.

Respectfully submitted,

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